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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,046	06/25/2003	Susanne Birkel	2660	3686

7590 10/26/2006

STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/606,046

Applicant(s)

BIRKEL ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5 and 7-15.
Claim(s) withdrawn from consideration: 17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

S. S. Gollamudi
Examiner
AU 1616

Continuation of 5. Applicant's reply has overcome the following rejection(s): The cancellation of claim 16 renders the obviousness double patenting rejections and art rejections over claim 16 moot. Only the rejections over claim 16 are withdrawn.

Briefly, applicant argues the examiner cannot utilize the comparative example disclosed by US '394. Applicant argues that US '394 teaches away from the combination of MAA/EA copolymer and Polyquaternium-46. Thus, it would not have been obvious to replace Polyquaternium-46 with Polyquaternium-7. Applicant argues assuming there is an equivalency between the two polymers, the combination would render a non-aerosol composition not an aerosol composition. Applicant further argues that Polyquaternium-46 and Polyquaternium-7 are different in structure and thus it would not have been obvious to replace one with the other. Applicant argues the unexpectedness of the instant Polyquaternium-7.

Firstly, the examiner has addressed this argument extensively in the Final Office Action. As stated previously comparative examples constitute prior art. See *In re Gurley*, 27, F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir 1994). Moreover the only difference between Schehlmann's inventive example 9 and comparative example 11 is the use of a propellant and not the hair styling composition itself. Further, Schehlmann teaches both have similar properties with regard to foam stability, curl retention, stickiness, wet compatibility, dry compatibility, and feel of hair; thus the only difference between both compositions is the use of a propellant. However, the propellant does not have a deleterious effect on the hair styling composition as noted by Schehlmann. The examiner points out that the premise of the instant rejection is not based on the use of a propellant versus a propellant free compositions, it is based on the obviousness of the hair setting polymers utilized in the hair styling composition. The examiner points out that US '394 suggests the use of Polyquaternium-7 on column 5 and exemplifies Polyquaternium-46. Thus, it is the examiner's position that a skilled artisan would reasonably expect success in substituting the exemplified polyquaternium-46 with the instantly claimed Polyquaternium-7. However, the examiner further relies on Bolich to demonstrate the functional equivalency of the two polymers. The examiner has not asserted that Polyquaternium-46 and Polyquaternium-7 have the same structure; hence the rejection is made under obviousness. The prior art establishes that both function the same in hair styling composition, i.e. cationic polymers that fix the hair; thus the rejection is based on functional, not structural, equivalence.

With regard to applicant's argument that the combination will yield a non-aerosol composition, this argument is unclear since the comparative example disclosed in US '394 teaches an aerosol and the rejection is based on the comparative example.

With regard to the unexpected results in the specification, although the examiner notes the specification, it is pointed out that applicant has not provided a comparison of the closest prior art to overcome the rejection. See MPEP 7163.02(e). Applicant provides the unexpectedness of the use of Polyquaternium-7 versus Polyquaternium-4 and Polyquaternium-16. The rejection is based on the substitution of Polyquaternium-46 with Polyquaternium-7. Applicant has not provided the unexpectedness of Polyquaternium-7 versus Polyquaternium-46. Thus, applicant has not shown any unobviousness to overcome the rejection.